UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,585	08/15/2001	Stephen D. O'Connor	266/263	2200

32763 7590 12/28/2004

NANOSTREAM, INC.
580 SIERRA MADRE VILLA AVE.
PASADENA, CA 91107-2928

EXAMINER	
WOOD, KEVIN S	

ART UNIT	PAPER NUMBER
2874	

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/931,585	O'CONNOR ET AL.	
	Examiner	Art Unit	
	Kevin S Wood	2874	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 August 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *5,7-10,13,14,21,24-27,30,32,33,36 and 42-61* is/are pending in the application.

4a) Of the above claim(s) *7-9,14,21,24-27,30,32,33,36 and 53-61* is/are withdrawn from consideration.

5)☒ Claim(s) *5,10,13 and 42-52* is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *08 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

SUPPLEMENTAL ACTION

Response to Election

1. Claims 7-9, 14, 21, 24-27, 30, 32, 33, 36, and 53-61 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 30 August 2004.

2. This application is in condition for allowance except for the presence of claims 7-9, 14, 21, 24-27, 30, 32, 33, 36, and 53-61 to an invention non-elected with traverse in the reply filed on 30 August 2004. Applicant is given ONE MONTH or THIRTY DAYS from the date of this letter, whichever is longer, to cancel the noted claims or take other appropriate action (37 CFR 1.144). Failure to take action during this period will be treated as authorization to cancel the noted claims by Examiner's Amendment and pass the case to issue. Extensions of time under 37 CFR 1.136(a) will not be permitted since this application will be passed to issue.

The prosecution of this case is closed except for consideration of the above matter.

Response to Arguments

3. The applicant has presented a variety of arguments with regards to why the Requirement for Restriction mailed on 11 August 2004 is improper. The examiner has thoroughly reviewed these arguments, but firmly believes the Requirement for Restriction to be proper.

The applicant argues that the restriction should have been made in the first office action. The examiner admits the application should have been restricted in the first action, however, the mere fact that the restriction was made after previous actions on the merits does not make it improper. The examiner apologizes for regrets any inconvenience that this late restriction has caused, but the restriction is proper due to the burden of searching multiple inventions.

The applicant's primary argument seems to be that the restriction is improper because there is no serious burden upon the examiner. The examiner disagrees with this argument. It is clear that the applicant is claiming multiple and distinct inventions which require separate and distinct searches within the art. The applicant cites the search reports provided by the examiner, by pointing out that the examiner text searched within all of class 385. The applicant claims this is proof that the search is not a burden. The examiner believes it proves the opposite. Instead of being able to focus the search on a few subclasses relevant to each invention, the examiner has been forced to search virtually an entire class of inventions to find the relevant prior art for all of the claimed inventions.

The applicant argues that there can be no burden because the examiner has already searched the inventions. The examiner respectfully disagrees with this argument. The examiner has attempted to search each of the claimed inventions, but has been unable to properly focus the searches for each of the claimed inventions.

It should be noted that at no point does the applicant argue that the restriction is improper for any reason other than it comes later in the prosecution of the application

than is typical. This seems to be an admission that the application should have been restricted, but the restriction is somehow too late and therefore searching it is no longer a serious burden on the examiner. The examiner respectfully disagrees with this argument. The applicant seems to be implying that the searching process is over, when in fact each of the inventions must be searched again prior to allowance. The applicant is also implying that any restriction after an action on the merits is inherently improper. That argument is contradicted by portions of the MPEP cited by the applicant in his arguments.

The applicant takes issue with the examiner's form paragraph, within Requirement for Restriction mailed on 11 August 2004, that stated the examiner called the applicant on 11 August 2004. The applicant states that the "tone" of the form paragraph implies that contact was made with the applicant. For clarification of the record, the examiner called Mr. Gustafson on 11 August 2004, but no contact was made and no voice mail message was left.

Allowable Subject Matter

4. Claims 5, 10, 13, and 42-52 are allowable.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin S Wood whose telephone number is (571) 272-2364. The examiner can normally be reached on Monday-Thursday (7am - 5:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney B Bovernick can be reached on (571) 272-2344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kevin S. Wood

AKM ENAYET ULLAH
PRIMARY EXAMINER